Remarks/Arguments

Claims 1-20 are pending in this application, and are rejected in the Office Action of December 20, 2010. Claims 1, 7-8, 11 and 16 are amended herein to more particularly point out and distinctly claim the subject matter Applicants regard as the invention.

Re: Patentability of Claims 1-20 under 35 U.S.C. §103(a)

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Publication No. 2003-132624 by Tsurui (hereinafter, "Tsurui") in view of U.S. Patent Publication No. 2002/0146238 by Sugahara (hereinafter, "Sugahara"), and further in view of U.S. Patent No. 6,469,718 issued to Setogawa et al. (hereinafter, "Setagawa"). Applicants respectfully traverse this rejection for at least the following reasons.

Claim 1, as amended herein, recites:

> "A method, comprising steps of:
> enabling a user to select a recording title stored on a digital storage medium in a first program chain for password protection, said first program chain being a single program chain according to DVD specifications;
> receiving a password from said user for said selected recording title;
> storing said password for said selected recording title on said digital storage medium in said first program chain;
> storing a password menu screen for said selected recording title on said digital storage medium in said first program chain, wherein said password menu screen prompts said user to input said password if playback of said selected recording title is attempted; and
> requiring said password to be input before playing back said selected recording title." (emphasis added)

As indicated above, amended claim 1 defines a method having features in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is

attempted, are all stored on a digital storage medium in a single program chain according to DVD specifications. Independent claims 8 and 16 are amended herein to recite subject matter similar to independent claim 1, albeit in different claim formats. Support for the amendments to independent claims 1, 8 and 16 may be found, for example, in the description of FIG. 2 in Applicants' specification.

None of the cited references, whether taken individually or in combination, discloses or suggests, *inter alia*, the aforementioned claim features in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are all stored on a digital storage medium in a single program chain according to DVD specifications.

In the Office Action of December 20, 2010, the Examiner ostensibly admits that neither Tsurui nor Sugahara discloses the aforementioned claimed feature in which a password menu screen (i.e., item (iii) above) is stored in a single program chain according to DVD specifications along with a user-selected recording title (i.e., item (i) above) and a user-assigned password for protecting the user-selected recording title (i.e., item (ii) above). In an attempt to remedy these admitted deficiencies of Tsurui and Sugahara, the Examiner relies on Setogawa, and specifically cites column 13, lines 1-15 thereof.

In response, Applicants submit that Setogawa is unable to remedy the aforementioned admitted deficiencies of Tsurui and Sugahara. First, the aforementioned cited portion of Setogawa refers to "[t]he single PGC 40 for the chapter menu..." (emphasis added - see column 13, line 1). That is, Setogawa teaches that a "chapter menu" is stored in a single PGC 40.

In contrast, the claimed invention refers to a "password menu screen" and specifically states that "said password menu screen prompts said user to input said password if playback of said selected recording title is attempted" (see for example,

claim 1 as amended). In other words, the claimed invention and Setogawa refer to completely different types of menus. In fact, Setogawa nowhere even mentions a "password menu screen [that] prompts said user to input said password if playback of said selected recording title is attempted", as claimed.

However, even assuming, *arguendo*, that the "chapter menu" of Setogawa included, or somehow corresponded to, a "password menu screen" (which it does not), there is absolutely no disclosure or suggestion by Setogawa that such a menu should be stored in combination with a user-selected recording title and a user-assigned password for protecting the user-selected recording title in a single program chain according to DVD specifications, as claimed.

Rather, Setogawa ostensibly teaches that a given [chapter] menu should be stored in its own independent program chain apart from other data. In this manner, Setogawa teaches away from the desirability of the claimed invention in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are all stored on a digital storage medium in a single program chain according to DVD specifications. As such, even if the teachings of Tsurui, Sugahara and Setogawa are combined, as proposed, the resulting combination still does not disclose or suggest each and every feature of the claimed invention.

Applicants further note that the Examiner alleges:

> "After reviewing the claims and the prior art, Examiner finds the notion of using one or more program chains moot. One of ordinary skill in the art could have used or tried any number of program chains to implement a password protected DVD as a matter of common sense." (emphasis added - see page 5 of the Office Action of December 20, 2010)

As indicated above, the Examiner ostensibly alleges that one of ordinary skill in the art could have simply arrived at the claimed invention through, for example, a process of trial and error. In other words, the Examiner ostensibly alleges that the cited

references could have been modified in a selective manner so as to arrive at the claimed invention.

In response, Applicants submit that the foregoing allegations of the Examiner are not supported by the teachings of the cited references themselves (as explained above), and therefore appear to be the result of impermissible hindsight reconstruction. Applicants further note that the mere fact that a prior art device could (in hindsight) be modified to produce a claimed invention is not a basis for an obviousness rejection unless the prior art suggests the desirability of such a modification. See, for example, *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989) ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to the form the [claimed] structure, '[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.'") and *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In this case, Applicants submit that none of the cited references, whether taken individually or in combination, discloses or suggests the desirability of the claimed invention in which: (i) a user-selected recording title, (ii) a user-assigned password for protecting the user-selected recording title and (iii) a password menu screen which prompts the user to input the user-assigned password if playback of the user-selected recording title is attempted, are all stored on a digital storage medium in a single program chain according to DVD specifications.

Therefore, for at least the foregoing reasons, Applicants submit that claims 1-20 are patentable under 35 U.S.C. §103(a) over the proposed combination of Tsurui, Sugahara and Setogawa, and withdrawal of the rejection is respectfully requested.

Conclusion

For at least the foregoing reasons, it is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that

have not been expressed. Finally, nothing in this paper should be construed as an intention to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Having fully addressed the Examiner's rejections, the Applicants believe this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6813, so that a mutually convenient date and time for a telephonic interview may be scheduled. No fee is believed due from this response. However, if a fee is due, please charge the fee to Deposit Account No. 07-0832.

Respectfully submitted,

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